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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,970	07/11/2003	Satoshi Kidooka	P23559	2858

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EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,970

Applicant(s)

KIDOOKA, SATOSHI

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-14-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The application claims priority to Japanese document 2002-207777 filed 7-17-02.

IDS submitted 10-14-03 has been considered.

Claims 1-12 are rejected below. Claim 1 is sole independent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7,9,10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Marucci et al. (6,582,451).

Independent claim 1 (parentheticals refer to Marucci)

A treatment tool (see figure 1a – *the rejection relies heavily upon this figure*) to be inserted into a human body through an endoscope (col. 1:20-25) comprising:

an elongated inserting portion (13) to be inserted through an accessory channel of the endoscope;

a supporting member (11) attached to a distal end of said inserting portion, said supporting member being provided with a slit (depicted at 74 in figure 1a);

a shaft (28, better depicted but not enumerated in figure 1c) attached (through the holes adjacent element 74 in figure 1a) to said supporting member so as to cross said slit in a width direction thereof (depicted figure 1b);

a pair of manipulation members (15a, 15b) pivotably supported by said shaft within said slit (depicted in figure 1g, *inter alia*) so as to open and close like a pair of pincers ("jaws"); and

a spacer (constituted by elements 24-25) located between said pair of manipulation members,

wherein said shaft (28) is supported by said spacer (24-25) so as not to come off from said supporting member.

2. The treatment tool according to claim 1, wherein said shaft (28) is pressed (depicted in figure 1e) into said spacer (24-25). Note the corresponding hole into which element 28 rests is depicted but not enumerated figure 1b).

3. The treatment tool according to claim 2, wherein said spacer (24-25) is provided with a through hole (depicted and enumerated –28- in figure 1a) having an inner diameter smaller than an outer diameter of said shaft (inherent for shaft to rest securely in through hole), said shaft being pressed (again, inherent) into said through hole.

4. The treatment tool according to claim 1, comprising a pair of said shafts (28 and 26 – figure 1a), both of said shafts being pressed into said spacer (24-25), each of said pair

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of manipulation members (15a, 15b) being pivotably mounted to respective one of said shafts so as to open and close like a pair of pincers ("jaws").

5. The treatment tool according to claim 4, wherein said spacer (24-25) is provided with a pair of through holes (figure 1a, element 28 and the non-enumerated proximal and longitudinally parallel hole) formed in parallel to each other, each of said through holes having an inner diameter smaller than an outer diameter of each of said shafts (26,28) (inherent for shaft to rest securely in through hole), said shafts being pressed (again, inherent) into respective one of said through holes.

6. The treatment tool according to claim 1, wherein said pair of manipulation members (15a, 15b; "jaws") are a pair of electrodes, and wherein said spacer insulates said electrodes from each other. See col. 6:33-40 for a disclosure of jaw members and associated modalities strongly related to electrode use such as radiofrequency and unipolar/bipolar electrocautery.

7. The treatment tool according to claim 6, wherein said spacer is made of poly-tetra-fluoro-ethylene. See col. 12:35-41. The disclosure of atraumatic plastic anticipates poly-tetra-fluoro-ethylene, an atraumatic plastic.

9. The treatment tool according to claim 6, wherein said manipulation members (15a, 15b; "jaws") are connectable to a high frequency power supply. See col. 6:33-40 for a

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disclosure of jaw members and associated modalities strongly related to connections to high frequency power supplies such as unipolar/bipolar electrocautery.

10. The treatment tool according to claim 1, wherein said supporting member (11) is made of insulating material. See col. 12:35-41 – plastic = insulating material.

11. The treatment tool according to claim 10, wherein said supporting member (11) is made of rigid plastic. See col. 12:35-41.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marucci et al. in view of Mayenberger (5,853,412).

Marucci is silent concerning ceramics.

Mayenberger discloses in an invention analogous to Marucci, ceramic parts (insulating by design). See Mayenberger claims 5 and 8.

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Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Marucci in view of Mayenberger by including as a design expedient ceramic parts for their insulating properties (motivation) as disclosed in Mayenberger.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
June 18, 2005

P

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER